

are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” (Emphasis added) Consistent with this requirement, the Manual of Patent Examining Procedures (M.P.E.P.) instructs Examiners to base a restriction on the **claims**. Some excerpts from Chapter 800 of the M.P.E.P., which governs restriction practice, are the following:

In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence. M.P.E.P. § 806.01. (Emphasis added).

Where the **claims** of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. M.P.E.P. § 806.03 (Para. 1). (Emphasis added).

Where an applicant files a divisional application claiming a species previously **claimed** but nonelected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made. M.P.E.P. § 806.04(h) (Para.1). (Emphasis added).

[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. M.P.E.P. § 806.04(h) (Para. 2).

The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” M.P.E.P. § 817 Outline of Letter (a)(2).


If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney at the number below.

Early and favorable consideration is earnestly solicited.

Please charge any additional required fees, including fees for any extensions of time necessary to render timely the filing of the instant Amendment and/or Reply to Office Action, for which applicant hereby respectfully petitions, or credit any overpayment not otherwise credited, to our deposit account no. 50-1698.

Respectfully submitted,
THELEN REID BROWN RAYSMAN & STEINER, LLP

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